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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,921	09/24/1999	MARK L. YOSELOFF	307.026US1	1046

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,921

Applicant(s)

YOSELOFF ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

MARK SAGER
PRIMARY EXAMINER

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 11-28, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *McCauley*, U.S. Patent 6,263,392 (July 17, 2001) in view of *Kelly*, U.S. Patent 6,015,344 (Jan 18, 2000).

McCauley discloses a system for controlling game devices using a universal controller and interface for reducing the cost of computer interface designs. *See col. 2:35-63*. It describes interfacing a variety of devices through a universal interface control module to a personal computer. In specific regards to the claims, *McCauley* discloses the following features of the claimed subject matter:

a) A universal computerized game controller operable to control a computerized video game.

See col. 1:14-57, 5:60-6:6. (Claims 1, 18, 19, 26, 27, 31-33)

b) A video display device providing a visual representation of a signal provided by the computerized game controller such that the video display device displays at least one visual image selected from the group (a) game status information; and (b) symbol elements that change with the play of the game. More specifically, *McCauley* discloses a system for controlling computer games. *See col. 2:22-34*. These typically provide a signal representing visual data from a game controller to a display including game status information (e.g. time, score, credits) and symbol elements that change (e.g. avatars, playing cards, reel symbols).

(Claims 1, 18, 19, 26, 27, 31-33)

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- c) A communication port communicatively coupled to the computerized game controller. *See col. 6:47-54 (Claims 1, 18, 19, 26, 27, 31-33)*
- d) An interface assembly comprising one or more user interface devices. *See col. 6:47-54 (Claims 1, 18, 19, 26, 27, 31-33)*
- e) An input/output (I/O) interface to communicatively couple the interface assembly to the communications port. *See cols. 55-60 and 9:34-41. (Claims 1, 18, 19).*
- f) An interface adapter configured to couple an interface assembly to a communication port operatively coupled to a computerized game controller comprising nonvolatile storage with instructions stored thereon, wherein the instructions are executable to cause a computer to execute a game via the interface assembly. *See col. 2:22-4:67. (Claims 18, 28, 32)*
- g) A universal game controller comprising a pin connector for attachment to a gaming apparatus; a connector to a circuit board wherein the circuit board has controls for peripheral devices; and the circuit board has a port connector connecting peripherals to a computer within the game apparatus. *See fig. 2-5; col. 5:61-8-27. (Claim 22)*
- h) An IBM compatible personal computer as a controller. *See col. 1:14-57. (Claims 2, 11)*
- i) Standard PC communication ports including serial, parallel, and universal serial bus (USB). *See col. 6:47-49. (Claims 3, 12)*
- j) User interface devices including buttons and joysticks. *See col. 6:23-34. (Claims 4, 5, 13, 14, 23)*
- k) A credit management device selected from a group including coin acceptors, coin recognition systems, currency acceptors, currency recognition systems, credit card readers, and smart card readers. *See col. 6:23-34, 8:9-51. (Claims 6, 15, 23)*
- l) A security device as a user interface device. *See col. 4:15-35. (Claims 7, 16)*

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- m) A security device for detecting spurious electrical discharges. *See col. 4:15-35. (Claims 8, 17)*
- n) A universal game controller wherein the port is connected to a computer to execute the controls for peripherals. *See fig. 2-5; col. 5:61-8-27. (Claim 24, 25)*

As listed above, *McCauley* describes all the features of the claimed subject matter except the following:

- a) Controlling a wagering game. *(Claims 1, 10, 18, 19, 22)*
- b) A random number generator to determine random outcomes. *(Claims 27, 28, 31-33)*
- c) A pay table identifying payouts based on the occurrence of random events. *(Claims 31-33)*
- d) Peripheral devices including pull-arms, touch screen displays, tilt switches, device integrity switches, game operating code and images. *(Claims 4, 8, 13, 17, 23)*
- e) An embedded motherboard employed as a controller. *(Claims 20, 21)*

Regardless of the deficiencies, the features were known in the art at the time of the invention and would have been obvious to an artisan of ordinary skill in view of *Kelly*.

Kelly discloses a multi-use gaming unit based on a PC platform offering a variety of games of skill and chance. *See fig. 5a; col. 3:28-22, 8:39-46, 10:23-29; 16:6-44, 27:3-17.* Most notably, the system may be configured to provide either arcade or wagering games. *See id.* In regards to the claims, *Kelly* describes numerous features of the claimed subject matter including the following:

- a) Controlling a wagering game. *See id. (Claims 1, 10, 18, 19, 22)*
- b) A random number generator to determine random outcomes. *See col. 22:5-25, 27:718; 29:5-16, 37:31-59. (Claims 27, 28, 31-33)*
- c) A pay table identifying payouts based on the occurrence of random events. *See fig. 9a, 14; col. 37:31-59; 56:40-60. (Claims 31-33)*

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- d) Peripheral devices including touch screen displays, levers, tilt switches, device integrity switches, security inputs, game operating code and images. *See col. 8:3-9:19, 14:11-16:5, 23:52-61, 33:14-28, 48:1-10. (Claims 4, 8, 13, 17, 23).*
- e) Employing an embedded motherboard as a controller. *See col. 14:11-15:18. (Claims 20, 21)*

Thus, in view of *Kelly*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the game system disclosed by *McCauley* to add a random number generator, payable, peripheral devices, and embedded motherboard, to provide more cost effective gaming system by taking advantage of reduced costs offered by the increased sophistication and capabilities of personal computer systems using universal processors and interfaces. *See McCauley, col. 2:8-38.* The gaming system would offer greater utility to game designers and operators because the devices would be simpler and cheaper to design, reconfigure, and repair.

Claims 9-11, 13-16 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Arcade Machine Retrofit*, <http://www.cygnus.uwa.edu.au/~jaycole/jaw/arcade.html> (Oct. 1996) (hereinafter "*Arcade*") in view of *Kelly*.

Arcade discloses a method for reconfiguring a commercial game apparatus having a harness for associating a universal computerized game controller with the apparatus's original peripherals. In general, *Arcade* suggests upgrading a game device by interfacing a universal controller (i.e. a personal computer) capable of executing a variety of games with existing components using a standard interface (i.e. JAMMA) as a cost effective replacement for an original specialized processor capable of executing only a single game. In specific regards to the claims, *Arcade* discloses the following features of the claimed subject matter:

- a) Removing an original special-purpose computerized game controller used to control a computerized game from the apparatus wherein the original computerized game controller

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was designed to and capable of working exclusively with a particular game apparatus.

(Claims 9, 29)

- b) Inserting a universal computerized game controller operable to control a video game that can be played on a game apparatus and an input/output interface the operatively couples the universal controller to user interface devices of the game apparatus. *(Claims 9, 29)*
- c) Sending signals from the computerized game controller through the input/output interface and harness to confirm proper communication between the computerized game controller and the user interfaced devices. *See pp. 3-4. (Claims 9, 29)* More specifically, this feature is satisfied by executing the game after completing the upgrade to determine whether the game controller is successfully transmitting a video signal to the video display and confirming the display of game data.
- d) After sending signals, the video gaming apparatus enables a video display associated with the game apparatus to provide a visual representation of a signal provided by the computerized game controller such that the video display device displays at least on visual image selected from the groups of (a) computerized game status information (e.g. credits, time, score) and (b) symbol elements that change with the play of the wagering game (e.g. avatars) *See pp. 3-4. (Claim 10)*. More specifically, this feature is satisfied by executing the game after completing the upgrade to determine whether the game controller is successfully transmitting a video signal to the video display and confirming the display of game data including credits, time, score, and avatars.
- e) The universal computerized game controller is an IBM compatible PC system. *See p. 2. (Claim 11)*
- f) User interface devices including joysticks and buttons. *See p. 2. (Claim 13)*

As listed above, *Arcade* describes all the features of the claimed subject matter except:

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- a) A wagering or slot game apparatus. (*Claim 9, 29*)
- b) A random number generator to determine random outcomes. (*Claim 29*)
- c) Credit management devices including coin acceptors, coin recognition systems, currency acceptors, currency recognition systems, credit card readers, smart card readers and security device. (*Claims 14, 15, 16*)

Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan of ordinary skill in view of *Kelly*.

Kelly discloses a commercial, multi-use gaming unit based on a personal computer that offers a variety of games of skill and chance. *See fig. 5a; col. 3:28-22, 8:39-46, 10:23-29; 16:6-44, 21:64-22:25, 27:3-17*. Most notably, the system may be configured to provide either arcade or wagering games. *See id.* In regards to the claims, *Kelly* describes numerous features of the claimed subject matter including the following:

- a) Controlling a wagering game or a video game. *See id. (Claims 9, 29)*. Wagering games include both video-type and mechanical reel-type games including slot machines, card games, and roulette. *See id.*
- b) A random number generator to determine random outcomes. *See col. 22:5-25, 27:718; 29:5-16, 37:31-59. (Claim 29)*
- c) Credit management devices including coin acceptors, coin recognition systems, currency acceptors, currency recognition systems, credit card readers, smart card readers and a security device, game operating code, and a store of images. *See 13:10-14:47, 15:50-55, 17:1-15, 23:53-61. (Claims 14, 15, 16)*

Hence, *Kelly* describes the remaining features of the claimed subject matter.

In view of *Kelly*, it would have been obvious to one of ordinary skill in the art to modify *Arcade*, wherein a universal controller is used to upgrade a specialized controller, to add wagering game hardware

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and software to provide a commercial gaming device upgraded with universal controller for executing variety of games as a cost effective method of replacing an special-purpose apparatus offering only a single game. The gaming system would offer greater utility and accessibility to customers and thereby generate greater revenue for operators.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Arcade* in view of *Kelly*, as applied to claims 9-11, 13-16 and 29 above, in further view of *McCauley*.

The method of upgrading a gaming system suggested by the combination of *Arcade* with *Kelly* additionally describes an input/output interface operatively coupled to a PC serial communication port. *See Arcade*, pp. 1-2. Hence the combination describes all the features of the claimed subject matter except coupling the input/output interface to a PC parallel port or USB port. Regardless of the deficiencies, the features were known in the art at the time of the invention and would have been obvious to an artisan of ordinary skill in view of *McCauley*.

McCauley discloses a system for interfacing multiple peripheral devices to a game controller through a input/output interface to take advantage of reduced costs made possible by the increased the sophistication and capabilities of personal computer systems with universal processors and interfaces. *See col. 2:8-38*. The systems universal input/output interface provides connections for the controllers USB, serial and parallel data lines. *See col. 6:7-54*.

In view of *McCauley*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of upgrading a gaming system suggested by the combination of *Arcade* with *Kelly* to add the features of coupling the input/output interface to a PC parallel port or USB port to take advantage of the reduced costs offered by personal computer systems with universal processors and interfaces.

Response to Arguments

Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new grounds of rejection. The Applicant's amendment necessitated the new grounds of rejection presented in this Office action.

Applicant's arguments filed 12 February 2002 have been fully considered but they are not persuasive. In response to applicant's argument that *Arcade* is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, *Arcade* is within the applicant's field of endeavor. First, the purpose of both electronic arcade devices and electronic gaming devices is to provide entertainment for users. It is known in the art for devices to operate in two modes to provide entertainment through either games or wagering in order to provide devices with greater accessibility to customers while meeting jurisdictional requirements. *Kelly* exemplifies an entertainment system that offers both wagering and non-wagering games within the same device at a variety of venues. See *fig. 5a; col. 3:28-22, 8:39-46, 10:23-29; 16:6-44, 27:3-17*. The system increased the utility of the device to operators by providing rewarding games of chance and skill regardless of jurisdictional limitations on gambling. Thus, as demonstrated by *Kelly*, the purpose of arcade and gaming devices are within the same field of endeavor.

Second, electronic entertainment devices and electronic gaming devices have common functionality. For example, *Kelly* describes non-wagering games that receive cash from players in return for the opportunity to play an entertaining game and win a payoff comprised of non-negotiable prize credits. In executing a game, entertainment game controllers execute computer executable instructions stored on read-only media to generate audiovisual presentations that generate random events and in

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response to player inputs. Comparatively, *Kelly* describes wagering games that receive cash from players in return for the opportunity to play an entertaining game and win a cash payoff. In executing a game, wagering game controllers execute computer executable instructions stored on read-only media to generate audiovisual presentations that generate random events and in response to player inputs. Hence, *Kelly* demonstrates that the functionality of electronic entertainment and wagering devices is within the same field of endeavor.

Third, the structures used in electronic entertainment devices and electronic gaming devices serve equivalent functions. Both types of systems employ credit management devices, random number generators, game controllers, video controllers, sound controllers, dispensers, currency acceptors, card readers, security sensors, coin hoppers, prize dispensers, player input devices, video displays, mechanical displays, network interfaces, etc. See e.g. *Kelly*, fig. 1-23. Hence, the structures used in electronic entertainment devices and electronic gaming devices are within the same field of endeavor.

Furthermore, *Arcade* is reasonably pertinent to the problem solved by the applicant. In independent claims 9 and 29, the Applicants claim a method for reconfiguring a computerized wagering game apparatus by removing an original special-purpose processor and installing a universal game controller. In comparison, *Arcade* describes a method for removing an original special-purpose video game processor and installing a universal game controller in the form of a generic, personal computer configured to control a plurality of games. Thus, although the Examiner maintains that *Arcade* is within the same field of endeavor, assuming *arguendo* that electronic entertainment devices are not within the same field of endeavor as electronic wagering devices, *Arcade* is analogous art because it is reasonably pertinent to the problem solved by the applicant.

In conclusion, *Arcade* is analogous art because it is clearly in the field of applicant's endeavor of electronic gaming devices and, moreover, is reasonably pertinent to the problem of upgrading an

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electronic entertainment device by interfacing a universal processor in replacement of a specialized processor.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703 308 4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.



Steven Ashburn
June 10, 2002



MARK SAGER
PRIMARY EXAMINER